

### **REMARKS**

In the Office Action, the Examiner rejected claims 1-21. By this paper, Applicants added new claim 22, and amended claims 1-8, 11 and 13-21. The new claim and the amendments do not add any new matter. Upon entry of these amendments, claims 1-22 remain pending in the present application and are believed to be in condition for allowance. In view of the foregoing amendments and the following remarks, Applicants respectfully request reconsideration and allowance of all pending claims.

### **Examiner Interview Summary**

As a preliminary note, Applicants provide a summary of an interview that was conducted via telephone on Thursday, September 13, 2007 between the Examiner and Applicants' attorney, Tait R. Swanson (Reg. No. 48,226). In the interview, the Examiner and Applicants' attorney agreed that changing the "adapted to" language to "configured to" in claims 1-6, 14 and 17-19, and removing the "adapted to" language from claim 7 would overcome the rejections under 35 U.S.C. § 112, second paragraph in items 4-6 of the present Office Action. *See* Office Action, p.3. Further, the Examiner and Applicants' attorney agreed that adding "machine readable medium" into the preamble of claim 17 would overcome the claim objection to claim 17 in item 2 of the present Office Action. *See* Office Action, p.2. Finally, the Examiner and Applicants' attorney agreed that copying the text of original claims 17-19 into the specification would address the objection to the specification in item 1 of the present Office Action. *See id.*

### **Objection to the Specification**

In the Office Action, the Examiner objected to the specification as failing to provide proper antecedent basis for the claimed subject matter. Although Applicants do not necessarily agree with the Examiner's objection, Applicants amended the specification as set forth above. Specifically, Applicants have amended paragraph [0033] to include text recited in the original claims 17-19 in accordance the agreement reached between the Examiner and Applicants' attorney in the telephone interview conducted on Thursday, September 13, 2007. In view of this amendment, Applicants respectfully request that the Examiner withdraw the objection to the specification.

### **Claim Objections**

In the Office Action, the Examiner objected to claim 17 due to the informality that claim 17 was directed towards a program comprising a medium. Although Applicants do not necessarily agree with the Examiner's objection, Applicants amended the claims as set forth above. Specifically, Applicants have amended the preamble of claim 17 to include a "machine readable medium" in accordance with the agreement reached between the Examiner and Applicants' attorney in the telephone interview conducted on Thursday, September 13, 2007. In view of this amendment, Applicants respectfully request that the Examiner withdraw the objection to the claims.

### **Claim Rejections under 35 U.S.C. § 112, Second Paragraph**

The Examiner rejected claims 1-7, 14, and 17-19 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicants regard as the invention. Applicants respectfully traverse this rejection.

### ***Legal Precedent and Guidelines***

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph, is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. *See* M.P.E.P. § 2173.02. Although the Examiner may take exception to the terms used in the claims, the patentee may be his own lexicographer. *Ellipse Corp. v. Ford Motor Co.*, 171 U.S.P.Q. 513 (7<sup>th</sup> Cir. 1971), *aff'd*. 613 F.2d 775 (7<sup>th</sup> Cir. 1979), *cert. denied*, 446 U.S. 939 (1980). The Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. *See* M.P.E.P. §§ 2173.01 and 2173.05; *In re Swinehart*, 439 F.2d 10, 160 U.S.P.Q. 226, (CCPA 1971). The Examiner is also reminded not to equate breadth of a claim with indefiniteness. *In re Miller*, 441 F.2d 689, 169 U.S.P.Q. 597 (CCPA 1971).

The essential inquiry pertaining to the definiteness requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. *See* M.P.E.P. § 2173.02. As set forth in Section 2173 of the Manual of Patent

Examining Procedure, definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. *See Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 U.S.P.Q.2d 1279, 1283 (Fed. Cir. 2000). Only when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite. *See Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1366, 71 U.S.P.Q.2d 1081, 1089 (Fed. Cir. 2004). Accordingly, a claim term that is not used or defined in the specification is not indefinite if the meaning of the claim term is discernible. *See Bancorp Services, L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1372, 69 U.S.P.Q.2d 1996, 1999-2000 (Fed. Cir. 2004).

### ***Deficiencies of Rejection***

Although Applicants do not necessarily agree with the Examiner's rejection, Applicants amended the claims as set forth above to expedite allowance of the present claims. Specifically, by the present response, Applicants have amended claims 1-6, 14 and 17-19 to change the "adapted to" language to "configured to," and Applicants have amended claim 7 to remove the "adapted to" language, in accordance with the agreement reached between the Examiner and Applicants' attorney during the telephone interview conducted on Thursday, September 13, 2007. For at least these reasons, among others, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 112, second paragraph.

### **Claim Rejections under 35 U.S.C. § 101**

In the Office Action, the Examiner rejected claims 17-21 under 35 U.S.C. § 101 as directed to non-statutory subject matter. Applicants respectfully traverse this rejection. However, although Applicants do not necessarily agree with the Examiner's rejection,

Applicants amended the claims as set forth above to expedite allowance of the present claims. Specifically, Applicants have amended the preamble of claim 17 to include a “machine readable medium” in accordance with the agreement reached between the Examiner and Applicants’ attorney during the telephone interview conducted on Thursday, September 13, 2007. Further, Applicants note that in item 10 of the Office Action, the Examiner suggested that making the above corrections to the specification and claims, as Applicants have done by the present response, will obviate the 35 U.S.C. § 101 rejection of claims 17-21. For at least these reasons, among others, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 101.

### **Claim Rejections under 35 U.S.C. § 102**

In the Office Action, the Examiner rejected claims 1-9 and 12-21 under 35 U.S.C. § 102(e) as anticipated by Song et al. (U.S. Publication No. 2004/0049673, hereinafter “Song”). Applicants respectfully traverse this rejection.

### ***Legal Precedent and Guidelines***

Anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under section 102, a single reference must teach each and every limitation of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the identical invention “*in as complete detail as contained in the ... claim*” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

### ***The cited reference is missing features recited by independent claim 1.***

Turning to the claims, the amended independent claim 1 recites, *inter alia*, “a cookie manager that is configured to prevent conflicting cookie values associated with the cookie by

evaluating a plurality of cookie values associated with multiple actions invoking the cookie and selecting an appropriate one of the plurality of cookie values” (emphasis added).

The cited reference does not teach or suggest “a plurality of cookie values associated with multiple actions invoking the cookie,” as recited by independent claim 1. In sharp contrast, the cited reference discloses maintaining a database of cookies that each includes only a single cookie value. Song, [0034]. For instance, in operation, “the user’s previously stored cookies are retrieved from their storage location 120 and communicated to the computing device 104 where they are made available to the browser 108.” Song, [0042]. Stated another way, the cited reference includes a plurality of cookies, the cookies being stored in a database and accessed by browsers from one or more locations. However, the cited reference does not disclose that the cookies have more than one value associated with them at a time. At best, the cited reference includes a plurality of cookies, but does not disclose a cookie having a plurality of cookie values associated with the cookie. In other words, each cookie has only a single value that is associated with it, as opposed to the plurality of cookie values as recited by the present claims. Further, because the reference does not teach or suggest “a plurality of cookie values associated with multiple actions invoking the cookie,” the cited reference cannot teach or suggest additional limitations including “evaluating a plurality of cookie values associated with multiple actions invoking the cookie” or “selecting an appropriate one of the plurality of cookie values,” as further recited by independent claim 1. In view of these deficiencies, among others, the cited reference cannot anticipate independent claim 1 and its dependent claims.

***The cited reference is missing features recited by independent claim 8.***

The amended independent claim 8 recites, *inter alia*, “providing a cookie manager that stores a plurality of cookie values associated with a cookie invoked by actions and that selects one of the plurality of cookie values based on the requests for data” (emphasis added).

The cited reference does not teach or suggest “a plurality of cookie values associated with a cookie,” as recited by independent claim 8. In sharp contrast, the cited reference merely discloses maintaining a database of cookies, wherein each cookie has only a single cookie value associated with the cookie. Further, because the reference does not teach or suggest “a plurality of cookie values associated with a cookie,” the cited reference also fails

to teach or suggest other claim limitations, including selecting “one of the plurality of cookie values based on the requests for data,” as further recited by independent claim 8. In view of these deficiencies, among others, the cited reference cannot anticipate independent claim 8 and its dependent claims.

***The cited reference is missing features recited by independent claim 14.***

The amended independent claim 14 recites, *inter alia*, “means for managing multiple cookie actions to maintain a current value of a particular cookie by evaluating a plurality of cookie values associated with the particular cookie and selecting an appropriate one of the plurality of cookie values” (emphasis added).

The cited reference does not teach or suggest “a plurality of cookie values associated with the particular cookie,” as recited by independent claim 14. In sharp contrast, the cited reference discloses maintaining a single cookie value for each cookie. Further, because the reference does not teach or suggest “a plurality of cookie values associated with the particular cookie,” the reference can not anticipate “evaluating” a plurality of cookie values, nor can it anticipate “selecting” one of the plurality of cookie values as further recited by independent claim 14. In view of these deficiencies, among others, the cited reference cannot anticipate independent claim 14 and its dependent claims.

Further, Applicants respectfully note that independent claim 14, which was rejected under 35 U.S.C. § 102(b) in view of the cited reference, includes means-plus-function language, as set forth in 35 U.S.C. § 112, paragraph 6, *and should be examined in accordance with this body of law*. As may be appreciated, with respect to 35 U.S.C. § 112, paragraph 6, an Examiner “may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination.” *In re Donaldson Co.*, 29 U.S.P.Q.2d 1845 (Fed. Cir. 1994); *see also* Manual of Patent Examining Procedure § 2181. Applicants note that proper interpretation of this claim must be performed with reference to the structure provided in the specification. Particularly, with regard to the “means for managing multiple cookie actions to maintain a current value of a particular cookie” recitation of claim 14, Applicants’ specification discloses a cookie manager for performing the recited function. *See, e.g.*, Application, paragraph [0027]; FIGS. 2-3. Applicants respectfully stress that the cited reference fails to teach or suggest such structure.

Accordingly, the Office Action failed to establish a *prima facie* case of unpatentability *in accordance with* the relevant statutory and precedential authority outlined above. Applicants respectfully submit that independent claim 14 is patentable over the cited reference. For at least these reasons, among others, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 102.

***The cited reference is missing features recited by independent claim 17.***

The amended independent claim 17 recites, *inter alia*, “a cookie manager ... configured to provide a desired cookie value for a response to a user request, wherein the desired cookie value is one cookie value selected from multiple cookie values set by different actions for a particular cookie” (emphasis added).

The cited reference does not teach or suggest “multiple cookie values set by different actions for a particular cookie,” as recited by independent claim 17. In sharp contrast, the cited reference discloses maintaining a single cookie value for each cookie. Accordingly, the reference cannot anticipate a “desired cookie value” that is “one cookie value selected from multiple cookie values...for a particular cookie,” as further recited by independent claim 17. In view of these deficiencies, among others, the cited reference cannot anticipate independent claim 14 and its dependent claims.

**Claim Rejections under 35 U.S.C. § 103(a)**

The Examiner rejected claims 10-11 under 35 U.S.C. § 103(a) as obvious over Song in view of Skea (U.S. Publication No. 2004/0049673, hereinafter “Skea”). Applicants respectfully traverse these rejections.

***Legal Precedent and Guidelines***

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). In addressing obviousness determinations under 35 U.S.C. § 103, the Supreme Court in *KSR International Co. v. Teleflex Inc.*, No. 04-1350 (April 30, 2007), reaffirmed many of its precedents relating to obviousness including its holding in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). In *KSR*, the Court also reaffirmed that “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the

prior art.” *Id.* at 14. In this regard, the *KSR* court stated that “it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does ... because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *Id.* at 14-15. In *KSR*, the court noted that the demonstration of a teaching, suggestion, or motivation to combine provides a “helpful insight” in determining whether claimed subject matter is obvious. *KSR, slip op.* at 14.

Furthermore, the *KSR* court did not diminish the requirement for objective evidence of obviousness. *Id.* at 14 (“To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”); see also, *In re Lee*, 61 U.S.P.Q.2d 1430, 1436 (Fed. Cir. 2002) (holding that the factual inquiry whether to combine references must be thorough and searching, and that it must be based on *objective evidence of record*).

When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). The Federal Circuit has warned that the Examiner must not, “fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *In re Dembiczak*, F.3d 994, 999, 50 U.S.P.Q.2d 52 (Fed. Cir. 1999) (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)).



It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983); M.P.E.P. § 2145. Moreover, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959); *see* M.P.E.P. § 2143.01(VI). If the proposed modification or combination would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); *see* M.P.E.P. § 2143.01(V).

***The cited references, taken alone or in hypothetical combination, fail to teach or suggest features recited by dependent claims 10-11.***

Claims 10-11 depend from independent claim 8, and are believed to be patentable over the cited references by virtue of their dependencies on independent claim 8, and additional features recited in each claim. With regard to their dependencies, the present independent claim 8, recites, *inter alia*, “providing a cookie manager that stores a plurality of cookie values associated with a cookie invoked by actions and that selects one of the plurality of cookie values based on the requests for data” (emphasis added). The cited references, taken alone or in hypothetical combination, fail to teach or suggest these claim features. Further, dependent claim 10 recites, *inter alia*, “maintaining a queue of cookies for a particular session of processing the user request”. The cited references, taken alone or in hypothetical combination, fail to teach or suggest a “queue of cookies.”

As discussed above with regard to the rejections of claim 8 under 35. U.S.C. § 102, the primary reference merely discloses maintaining a single cookie value for each cookie. Moreover, the secondary reference fails to obviate the deficiencies of the primary reference. Instead, the secondary reference discloses maintaining a queue that includes a cookie as a part of the “next message” sent to the customer’s system. Skea, [0173]. The secondary reference does not disclose that the cookie has more than a single cookie value associated with it, nor does it disclose more than a single cookie being queued in the “next message.” In other words, the secondary reference does not disclose more than one value associated with a

cookie, and it merely discloses a single cookie that is queued. In addition, neither of the references teaches or suggests a “queue of cookies” as recited by dependent claim 10. The primary reference merely teaches a plurality of cookies, and the secondary reference merely teaches a single cookie queued in a “next message.” In view of these deficiencies, among others, the cited references, taken alone or in hypothetical combination, cannot render obvious the current independent claim 8 and its dependent claims 10-11.

For at least these reasons among others, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103.

***Improper Combination - Lack of Objective Evidence of Reasons to Modify/Combine***

In addition, the Examiner has not shown objective evidence of the requisite motivation or suggestion to modify or combine the cited references to reach the present claims. As summarized above, the KSR court did not diminish the requirement for objective evidence of obviousness. KSR, slip op. at 14 (“To facilitate review, this analysis should be made explicit. *See In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”); see also, *In re Lee*, 61 U.S.P.Q.2d 1430, 1436 (Fed. Cir. 2002) (holding that the factual inquiry whether to combine references must be thorough and searching, and that it must be based on objective evidence of record). In the present rejection, the Examiner combined the cited references based on the conclusory and subjective statement that it would have been obvious “to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Song...because Song discusses storing the cookies in general terms (see paragraph 52 of Song) and Skea shows one specific way of storage of cookies.” Office Action, p. 8. Accordingly, Applicants respectfully request the Examiner to produce objective evidence of the requisite motivation or suggestion to combine the cited references, or remove the foregoing rejection under 35 U.S.C. § 103.

**Conclusion**

Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

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